

claims 3 and 4, in further view of Anderson. Claim 1 has been amended to define the scope bars of applicant's invention in means plus function so as to emphasize the importance of the scope bars' structure in terms of the function performed. As seen in applicant's Figs. 1, 4 and 5, the inner end portions of both scope bars (which are the ends juxtaposed to one another) are cylindrical and the juxtaposed inner ends are circular with their circular perimeter edges being of the same diameter as the diameter of the cylindrical end portions. As a consequence of this structure, when the inner end portions are juxtaposed as shown in Figs. 4 and 5, with the inner ends themselves in very close proximity to one another, any misalignment, such as is shown in Fig. 5, can be felt by the user. The user can run his or her finger along the cylindrical end portions and any misalignment can be immediately and easily felt as the user's finger runs across the gap between the two scope bars. As shown in Fig. 5, the protruding edges at "X" and "Y" can be felt by the user because the circular perimeter edge of each bar end has the same diameter as the adjacent cylindrical end portion. These circular perimeter edges are not recessed inward of the cylindrical end portions but are, rather, coincident with the cylindrical surfaces of these end portions.

In marked contrast to this structural relationship, the articles shown in the Brownells catalog have conically-tapered end portions that taper to points. These points cannot be felt by a user because they are recessed from the outer surfaces of the alignment rods. Furthermore, because they are pointed ends, the direction or angle of misalignment is very difficult to detect visually.

The Callahan reference does not meet the limitations in amended claim 1. Furthermore, there is no teaching in either the Brownells catalog or in Callahan to suggest modifying Brownells articles.

First of all, Callahan's juxtaposed elements 22, 23 are members to be aligned - they are not aligning members; the

aligning member of Callahan is element 27 and is a single shaft. The Examiner is incorrect in stating that "Callahan discloses at Column 1, lines 45-50 that it is known in the art to provide a planar end on shafts 23 to visually determine of(sic) the shafts a(sic) in alignment." The whole purpose of Callahan is to provide for automatic alignment of the two shafts as a result of using a single shaft 27 - the two shafts to be aligned, 22, 23 or 40, 43 could be of different diameters or of some other different configuration and yet, because of the use of aligning shaft 27, still become axially aligned. The planar ends of shafts 22, 23 play no part in the alignment process. Fig. 2 of Callahan shows how his alignment device would be typically used, where motor shafts 40, 43 are to be aligned. In Fig. 2 Callahan shows that motor shafts 40, 43 are typically chamfered at their outer ends; this to prevent them from being chipped or shattered. It is the single element 27 that aligns shafts 22, 23 or 40, 43; not vice versa. In other words, the ends of shafts 22, 23 or 40, 43 are not used in any alignment process, they are merely ends of two shafts that are to be aligned by other means - namely element 27.

Secondly, The Brownells scope alignment rods require the presence of pointed ends. The advertisement on page 194 states "Clamp one rod in each ring; if the points don't touch, they're out of alignment." In other words, Brownells requires pointed end so that the pointed ends can touch one another when the rods are aligned. It is not proper to ignore Brownells teaching of the importance of pointed ends and suggest that those pointed ends could be replaced by circular, planar ends, for to do so would destroy the Brownell structure and render it impossible to function as specified. Substitution of Callahan's motor shaft end configuration in place of the Brownell pointed ends would render the Brownell scope alignment rods incapable of performing as specified.

The Examiner's attempt to combine the teachings of the cited references is based on hind-sight reasoning. Likewise, the Examiner has used hind-sight reasoning in attempting to

substitute elements from one reference into another where no basis is present in either to suggest the substitution. As stated by the Court in re Sernaker, 217 USPQ 1, 6 (1983) in discussing an earlier case, "The lesson of this case appears to be that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings." Applicant submits that, as in the Sernaker case, the claimed invention in the present case is nonobvious over the references because there is nothing in the references that would suggest that an improvement in "a pair of telescopic sight mount aligning bar[s] means,"

whereby a telescopic sight mount misalignment will be revealed by a misalignment of said peripheral edges relative to one another with such misalignment being palpable to the touch of a user when the two inner ends are closely juxtaposed.

might be achieved by combining their teachings; nor is there anything in the references that would suggest that this improvement as a result of,

each bar means comprising an elongated rod having a cylindrical inner end portion with a planar circular inner end bounded by a circular peripheral edge having the same diameter as the diameter of said cylindrical inner end portion,

might be achieved by combining their teachings. The problems addressed by each of the references are different from the problems addressed by the other reference and also different from the problems addressed by the present invention.

The Examiner's incorrect conclusion of obviousness appears to be the result of his failure to view the invention as a whole and each of the references as a whole. There are many cases which state the requirement that the invention must be viewed as a whole and that each of the references must also be viewed as a whole when the issue of nonobviousness is confronted. In

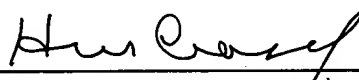
particular, the Examiner is not permitted to disregard disclosures in the references that diverge from and teach away from the invention at hand; W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 311 (CAFC 1983).

In view of the foregoing, it is submitted that amended claim 1, and claims 2-4 dependent therefrom, patentably distinguish over the art of record. Withdrawal of the rejection of claims 1-4 and the allowance of these claims are solicited.

Respectfully submitted,

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Date: 2/11/97
~~January 4, 1996~~

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